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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,436	09/29/2005	Jens Storkel	02894-0711/Z07814Q	6040
27752 7590 06/07/2011 THE PROCTER & GAMBLE COMPANY Global Legal Department - IP Sycamore Building - 4th Floor 299 East Sixth Street CINCINNATI, OH 45202				
EXAMINER				
CHIN, RANDALL E				
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3723				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/535,436

**Applicant(s)**

STORKEL ET AL.

**Examiner**

Randall Chin

**Art Unit**

3723

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 May 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,5-9,11-14 and 16-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-9,11-14,16,17,19-27,29 and 30 is/are rejected.
- 7) ☒ Claim(s) 18 and 28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3, 5-9, 11-14, 16, 17, 19-27, 29 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Nishihira et al. 4,330,578 (hereinafter Nishihira).

As for claim 1, the patent to Nishihira discloses in Figs. 1 and 2 an injection molded part 1 (col. 1, lines 7-9 and 36-50) comprising a body 11 injection-molded from a first plastic (col. 2, lines 20-21), wherein the body comprises a plastic that is transparent (col. 2, lines 31-42), a printed ink layer of desired pattern or decoration 3 (col. 2, lines 43-45) clearly having a decorative visible side and a rear side, wherein the decoration is applied with the visible side to "a surface" (not positively recited but still considered broad) of the body 11 (Figs. 1b and 1e), such that the decorative visible side is protected from damage during a "subsequent" (since body 11 and encapsulation 12 can **both** be transparent and thus the decoration can be visible from either side as suggested/implied in col. 3, lines 14-26) injection-molded encapsulation 12 of a second plastic covering the decoration 3 (Fig. 1e; col. 3, lines 14-17). It should be noted that as well as the above quoted term "subsequent" is understood here, the final product encapsulation 12 which is "subsequently" formed onto body 11 still protects the visible

side of the decoration 3. Further, it should be noted that claim 1 is an **apparatus** claim and not a method claim and methods of forming are not germane to patentability in apparatus claims so any other claim construction for the term "subsequent" other than what is the final product of the final molded part here is of no patentable moment. In other words, only the final apparatus product is what is of patentable significance here. In any case, as well as the language of claim 1 is understood, in the **final product** of Nishihira (e.g., Figs. 1d or 1e), the recitation "such that the decorative visible side is protected from damage during a subsequent injection-molded encapsulation of a second plastic covering the decoration" is still deemed met.

As for claim 3, the encapsulation 12 covers one or more decoration-free regions of the body 11 with the first and second plastics bonded to each other (Figs. 1b and 1e; col. 1, line 62 to col. 2, line 2).

As for claim 5 reciting that the first and second plastics have different degrees of hardness, Nishihira teaches use of a variety of different materials or resins and also implies that the first and second plastics could well be **different** from one another (col. 2, lines 31-37 and col. 3, lines 17-26) thus inherently providing different degrees of hardness, at least even to a slight degree.

As for claim 6, the decoration-free regions are arranged in an edge region adjacent the decoration 3 (Figs. 1b and 1e).

As for claim 7, the encapsulation 12 extends over the body 11 "beyond the edge region" (a broad phrase) adjacent the decoration 3 (Fig. 1e).

As for claim 8, the decoration-free regions are arranged in an interior region of the decoration 3 (Fig. 1e).

As for claim 9, the body 11 has, in one or more of the decoration-free regions or "recesses" (i.e., to the extent that these "recesses" are shown in Figs. 1-3 of the instant application) which are open toward its surface and are filled by the second plastic of the encapsulation 12 (Fig. 1e). Applicant is cautioned with the entry of nay new matter.

As for claim 11, the surface of the body 11 bearing the decoration 3 is substantially planar (Figs. 1b and 1e).

As for claim 12, the surface of the body 11 bearing the decoration 3 is convexly curved, at least at the **corners** (Fig. 1e).

As for claim 13, "an edge region" (a broad recitation) which can be **any side** portion/wall of the surface of the body 11 surrounding the decoration 3 is formed at a lower-lying level than the surface covered by the decoration 3 (Figs. 1b or 1e).

As for claim 14, the edge region of the surface of the body 11 "surrounding" (a broad term) the decoration 3 is formed in a convexly rounded manner, at least at the **corners** (Fig. 1e).

As for claims 16 and 17 reciting that the decoration is applied by means of a hot transfer film, by means of a metallized film, or by printing, methods of forming are not germane to patentability in apparatus claims. In any case, in Nishihira, the decoration is applied by printing (col. 2, lines 44-50).

As for claims 19 and 30 reciting that the part is a toothbrush body, no inference or assumption will be made that the "part" includes for example, bristles or a "cleaning" element(s). In any case, Nishihira's part 1 can be considered a toothbrush body.

As for claim 30, the encapsulation 12 covers one or more decoration-free regions of the toothbrush body with the first and second plastics 11, 12, respectively, bonded to each other (Fig. 1e; col. 1, line 62 to col. 2, line 2).

As for claim 20, Nishihira teaches in Fig. 1 (see also explanation provided for claim 1 above) a method of injection molding a part 1 (col. 1, line 51 to col. 3, line 5), the method comprising injection molding a body 11 from a first plastic, the body comprising a transparent or translucent plastic, applying at least a two-dimensional decoration 3 to a surface of the body 11, the decoration 3 having a decorative visible side and a rear side, wherein the decoration 3 is applied with its decorative visible side to the surface of the body, such that the decorative visible side is visible through the body 11, and covering the applied decoration with an encapsulating layer 12 of a second plastic, the second plastic injection molded over the rear side decoration 3. It should be noted that since body 11 and encapsulation 12 can **both** be transparent, as already mentioned above in claim 1, either the "visible" side or the "rear" side can be visible through the body 11 and encapsulation 12 thus the language of claim 20 is still deemed met by Nishihira's Figs. 1a-1e (see also col. 3, lines 14-26). It should be further noted that the language of claim 20 is broad since the "visible side" could *actually be* the "rear side". In other words, the claim does not specifically recite that the "visible side" is opposite to or on an opposite side from the "rear side". Furthermore, the use of the phrase "molded

over" in claim 20, line 11, is broad in that "molded over" just means "over" or "on top of" but not necessarily **contiguously contacting** the rear side.

As for claim 21, the encapsulating layer 12 covers a decoration-free region of the body and the first plastic bonds with the second plastic in the decoration-free region (Fig. 1e).

As for claim 22 reciting that the first and second plastics have different degrees of hardness, Nishihira teaches use of a variety of different materials or resins and also implies that the first and second plastics could well be **different** from one another (col. 2, lines 31-37 and col. 3, lines 17-26) thus inherently providing different degrees of hardness, at least even to a slight degree.

As for claim 23, the decoration-free region is an edge region adjacent the decoration 3 (Fig. 1e).

As for claim 24, the encapsulating layer 12 extends over the body 11 "beyond the edge region" (a broad phrase; Fig. 1e).

As for claim 25, the decoration-free region is arranged in an interior region defined within the decoration 3 (Fig. 1e).

As well as claim 26 is understood, the body 11 has a "recess" (i.e., to the extent that this "recess" is shown in Figs. 1-3 of the instant application) in the decoration-free region which are open toward its surface and are filled by the plastic of the encapsulating layer 12, the recess defining a print pattern (col. 2, lines 44-66) which would at least be a symbol (Fig. 1e).

As for claim 27, "an edge region" (a broad recitation) which can be **any side** portion/wall of the surface of the body 11 surrounding the decoration 3 is formed at a lower-lying level than a covered region of the surface under the decoration 3 (Figs. 1b or 1e).

As for claim 29 reciting that the part is a toothbrush body, no inference or assumption will be made that the "part" includes for example, bristles or a "cleaning" element(s). In any case, Nishihira's part 1 can be considered a toothbrush body.

#### ***Allowable Subject Matter***

3. Claims 18 and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

4. Applicant's arguments filed 27 May 2011 have been fully considered but they are not persuasive.

All of Applicant's arguments have been considered in their entirety and are deemed adequately addressed and explained by the above art rejections. It will be added that Applicant's argument(s) that Nishihira does not teach an injection molded part having a body injection-molded from a first plastic and a decorative visible side of a decoration applied to the surface of the body such that the decorative visible side is protected from damage during a subsequent injection-molded encapsulation of a



second plastic covering the decoration as required by claim 1 is unpersuasive since claim 1 is an **apparatus** claim and not a method claim and methods of forming are not germane to patentability in apparatus claims so any other claim construction for the term "subsequent" other than what is the final product of the final molded part here is of no patentable moment. In other words, only the final apparatus product is what is of patentable significance here. Only the **final product** is patentably relevant in apparatus claim 1. In any case, as already explained above for claim 1, the language of claim 1 is still deemed met by Nishihira. As for these arguments with respect to claim 20, it is noted that the features upon which applicant relies (i.e., body injection-molded from a first plastic and a decorative visible side of a decoration applied to the surface of the body such that the decorative visible side is protected from damage during a subsequent injection-molded encapsulation of a second plastic covering the decoration is/are not recited in the rejected claim 20. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randall Chin whose telephone number is (571) 272-1270. The examiner can normally be reached on Monday through Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on (571) 272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Randall Chin/  
Primary Examiner, Art Unit 3723